

### **REMARKS/ARGUMENTS**

Claims 1-14 are pending in the present application. Claims 11 and 12 have been amended for minor editorial purposes to recite “B)” instead of “B2)”, which is supported by the specification and claims as originally filed. No new matter has been added. Accordingly, entry of the amendments is kindly requested. Reconsideration of the pending claims of the present application is requested in view of the following remarks.

#### **Claim Objections**

Claims have been amended, as indicated above, to recite “B)” for antecedent basis. Accordingly, reconsideration and withdrawal of the objection is respectfully requested.

#### **Rejection under 35 U.S.C. § 103(a)**

The rejection of claims 1-14 under 35 U.S.C. § 103(a) as obvious over Gareiss et al. (U.S. Patent No. 5,712,336) in view of Davis et al. (GB 2,324,797) is respectfully traversed in view of the reasons of record and those discussed below.

As appreciated again by the Office, Gareiss et al. does not describe or suggest component B), the hyper or highly branched polycarbonate of the present claims. Indeed, a comparison of its disclosure and the claimed thermoplastic molding composition, shows that it is apparent that the reference fails to render obvious all the of the recited features of Applicant’s claim 1.

However, according to the Office, “Gareiss teaches that the thermoplastic molding composition is open to the addition of various additives . . . and Davis teaches that the additive can be the hyperbranched polymer. Applicant’s argument that Gareiss does not suggest the hyperbranched polymer is not persuasive because in a 103(a) rejection one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.” Final Office Action at page 11, para. 31.

However, it is respectfully pointed out that Applicant has not attacked the references individually, but shown that when determining the scope and contents of the prior art, the Office must consider the prior art in its entirety, including any disclosure that would lead away from the claimed invention. (*See, W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984) (indicating that prior art

references must be considered in their entirety, as a whole, including any disclosures that lead away from the claims at issue.))

In particular, regarding Gareiss et al. when compared to the presently claimed invention, there is no provision of a thermoplastic polyester molding composition with the highly branched or hyperbranched polycarbonates, or any indication that highly branched or hyperbranched polycarbonates are obtainable by a low-cost simple industrial process. Further, other than hindsight of the present specification, there is no indication or expectation of achieving a composition having the combined good flowability and mechanical properties of the claimed invention.

Regarding Davis, as Applicant has previously point out, the polycarbonates described in the reference are entirely different from and clearly unobvious over the claimed invention, even if combined with Gareiss et al. *See In re Ward and Murphy*, Appeal No. 2007-3733 (explaining that “a searching comparison of the claimed invention - *including all its limitations* - with the teaching of the prior art” must be made in an obviousness analysis); *see also Ex parte Martin Haubner and Rolf Pinkos*, Appeal No. 2009-0449 (reversing an obviousness rejection and explaining that “in rejecting *process* claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a case of prima facie obviousness”). In the present case, the initial burden has not been met, in view of the clearly non-obvious comparisons.

Accordingly, the claimed invention is unobvious over the references of record. Therefore, reconsideration and withdrawal of the rejection are requested.

### **Provisional Double Patenting Rejections**

Applicant acknowledges the Office’s indication that that the provisional double patenting rejections have been maintained. Applicant requests that the rejections be held in abeyance until allowable subject matter is indicated.

In view of the foregoing, consideration and allowance are respectfully solicited.

The Office is authorized to charge any necessary fees to Deposit Account No. 03-2775.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 03-2775, under Order No. 12810-00334-US1 from which the undersigned is authorized to draw.

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Respectfully submitted,

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